

REMARKS

In the Office Action dated December 14, 2004, claims 1-22 were presented for examination. Claims 1-10, 16, and 18-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ohlund*, U.S. Patent No. 6,233,971, in view of *Belknap.*, U.S. Patent No. 5,018,053. Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Ohlund*, U.S. Patent No. 6,233,971, in view of *Belknap.*, U.S. Patent No. 5,018,053, and further in view of *Glatter*, U.S. Patent No. 4,459,645. Claims 12-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ohlund*, U.S. Patent No. 6,233,971, in view of *Rapisarda*, U.S. Patent No. 6,238,056. Claim 17 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Ohlund*, U.S. Patent No. 6,233,971, in view of *Belknap.*, U.S. Patent No. 5,018,053, and further in view of *Rapisarda*, U.S. Patent No. 6,238,056.

The following remarks are provided in support of the pending claims and responsive to the Office Action of December 14, 2004 for the pending application.

**I. Rejection of Claims 1-10, 16, and 18-22 under 35 U.S.C. §103(a)**

In the Office Action dated December 14, 2004, the Examiner assigned to the application rejected claims 1-10, 16, and 18-22 under 35 U.S.C. §103(a) as being unpatentable over *Ohlund* ('971) in view of *Belknap* ('053). The comments pertaining to *Ohlund* provided in response to the First Office Action are hereby incorporated.

Applicants have canceled claims 1-10 and 19, and as such will not comment directly on those claims.

As noted in the Second Office Action, the Examiner uses the *Ohlund* patent to support the flexible conductor, the loop having first and second discontinuities, the clasp, the medallion and its associated properties, and the light emitting diode as claimed by Applicants. The Examiner uses the *Belknap* patent to support the medallion consisting of a single piece and the

aperture within the medallion. As noted in the Response to the First Office Action, the patent of *Ohlund* discloses a jewelry item with an ornamental crystal and a housing mounted onto an exterior surface of the crystal, wherein the housing has a cavity in which a light emitting diode may reside to shine light into the medallion. It is clear that the light emitting diode of *Ohlund* emits light into the medallion from an area outside of the external surfaces of the medallion. *Belknap* is used by the Examiner to teach the medallion consisting of a single piece, and to support the aperture formed within the medallion. However, Applicants have amended claim 16 to further define the aperture formed within the medallion. More specifically, Applicant's medallion includes a single aperture that essentially forms a channel between two exterior surfaces. The light emitting diode of Applicants has two posts that extend from two different surfaces of the diode, i.e. a surface mount diode. The light emitting diode of *Ohlund* and *Belknap* are bullet mounted diodes, as is clear by the structure of two parallel posts extending from the same surface of the diode. Applicant's have amended claim 16 to specify that their medallion is limited to one aperture to receive the light emitting diode. As shown in Figs. 1, 2, and 4 of *Belknap* it is clear that there is a minimum of two apertures formed in the medallion, with each aperture receiving one of the posts of the light emitting diode and with each aperture extending into the same exterior surface of the medallion. However, Applicant's amended claim 16 does not require more than one aperture since the single aperture of Applicant extends from one exterior surface to a second exterior surface. Applicant's invention functions on a single aperture because it is designed to accommodate a light source that has a different structure than that taught in *Ohlund* and *Belknap*.

There is no teaching in *Ohlund* for a medallion consisting of a single piece. The medallion of *Ohlund* is actually comprised of two elements, the medallion and the housing with the light emitting diode placed therein. Furthermore, the medallion of Applicants, as distinguished from the medallion of *Ohlund*, includes a single aperture to receive a light emitting diode. As noted above, the structure of the medallion of Applicant is clearly and specifically claimed and distinguished from the medallion of *Ohlund*. With respect to the aperture element placed in amended claim 16, Applicants clearly claim the medallion "consisting of a single

aperture to receive a light emitting diode". The medallion of *Belknap*, which does consist of a single piece, is not limited to a single aperture. In fact, it is clear that the medallion of *Belknap* consists of a minimum of two apertures, as shown in the two top views, i.e. Figs. 1 and 2. "To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." MPEP §2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *Ohlund* does not teach the structure of the medallion and the aperture within the medallion as claimed by Applicant. *Belknap*, which may allegedly teach the medallion structure of Applicants as consisting of a single piece, does not teach the medallion limited to a single aperture formed in the medallion. Accordingly, the combination of *Ohlund* and *Belknap* does not teach or suggest the making of Applicant's claimed elements or provide a reasonable expectation of success.

In order to apply *Ohlund* to Applicant's pending application, *Ohlund* must be modified and reconfigured to a medallion consisting of a single piece and a single aperture to support a light emitting diode. The medallion consisting of only a single aperture goes against the teachings of both *Ohlund* and *Belknap*. "Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" MPEP §2143.01 (citing *In re Mills*, 916 F.2d 680, 682, 16 USPQ 2d. 1430 (Fed. Cir. 1990)). *Ohlund* does not teach or suggest a medallion consisting of a single piece and a single aperture formed therein. To read *Ohlund* as providing or supporting either or both of these elements would require a modification to the invention of *Ohlund* not envisioned or required. Similarly, to read *Belknap* as providing a single aperture formed in their medallion would require a modification to the invention of *Belknap* not envisioned or required. The only suggestion for a medallion consisting of a single piece with a single aperture is derived from Applicant's invention. Absent Applicant's invention, there is no suggestion or motivation within *Ohlund* or *Belknap* for such modifications. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece together the teachings of the prior art so that the

claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991)). Yet this is the very process that the Examiner has attempted to undertake. Although Applicant's invention may appear to combine elements found in *Ohlund* and *Belknap*, "the inquiry under [35 U.S.C.] §103 is whether prior use makes the picture of the jigsaw puzzle, rather than its pieces obvious." *Kori Corp. v. Wilco Marsh Buggies & Draglines*, 708 F.2d 151, 155 (5<sup>th</sup> Cir. 1983). The entirety of Applicant's invention is greater than the sum of the parts that comprise the novelty of the invention. "[T]he linchpin is not whether the individual components of the patent were obvious at the time of the invention, but whether the aggregation produced a new or different result or achieved a synergistic effect." *Id.* (citing *Continental Oil co. v. Cole*, 634 F.2d 188, 197 (5<sup>th</sup> Cir. 1981)). Unlike *Ohlund* or *Belknap*, Applicant's medallion is limited to a single aperture that accommodates a light emitting diode in the form of a surface mount diode. Accordingly, Applicants respectfully contend that the teachings of *Ohlund* and *Belknap* do not teach the elements of the single piece medallion together with a single aperture formed therein, as required by the limitations of Applicants amended claim 16.

## **II. Rejection of Claim 11 under 35 U.S.C. §103(a)**

In the Office Action dated December 14, 2004, the Examiner assigned to the application rejected claim 11 under 35 U.S.C. §103(a) as being unpatentable over *Ohlund* ('971) in view of *Belknap* ('053), and further in view of *Glatter* ('645). The comments pertaining to both *Ohlund* and *Glatter* provided in response to the First Office Action are hereby incorporated. Applicants have canceled claim 11, and as such any response to this claim is now moot.

## **III. Rejection of Claims 12-15 under 35 U.S.C. §103(a)**

In the Office Action dated December 14, 2004, the Examiner assigned to the application

rejected claims 12-15 under 35 U.S.C. §103(a) as being unpatentable over *Ohlund* ('971) in view of *Rapisarda* ('056). The comments pertaining to *Ohlund* provided in response to the First Office Action and addressed to the rejection of claims 1-10, 16, and 18-22 above are hereby incorporated. Applicants have amended claim 12 to specify the structure of the medallion and its aperture and removed the language pertaining to the surface mount diode. Claim 23 has been added as a dependent claim stemming from claim 12 that specifies that the light emitting diode is a surface mount type.

The *Rapisarda* ('056) patent relates to a spring mounted light that uses a light emitting diode as its light source. A motion sensor is provided in the electrical circuit in communication with the light emitting diode to complete the circuit in response to motion. Although the '056 patent discloses that the light emitting diode may be in the form of a surface mount light emitting diode, it is taught for use in a shoe in combination with a spring and a motion sensor. The Examiner's claim that *Rapisarda* provides motivation or suggestion that the surface mount light emitting diode taught therein may be utilized in the article structure of Applicant stems from the one instance where the term "surface mount LED" is used. *Rapisarda* does not even teach how the surface mount light emitting diode may be embedded within an article equivalent to that of Applicant, i.e. the medallion, or why such an incorporation would benefit the invention of *Rapisarda*.

Absent Applicant's invention, there is no suggestion or motivation to employ a surface mount light emitting diode in the medallion of *Ohlund* for such a modification. The Examiner is merely using hindsight reconstruction to apply the combination of *Ohlund* and *Rapisarda* to Applicants' invention. The Examiner claims to have found each of the elements claimed by Applicants, but has not found the motivation for applying the combination of the references to the article of Applicants. "If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to

defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’ ” *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998), citing *Sensorics, Inc. v. Aerasonic Corp.*, 81 F.3d 1566, 38 USPQ2d 1551 (Fed. Cir. 1996). Accordingly, Applicants reassert that the Examiner is improperly using hindsight reconstruction to negate patentability.

“To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the invention and with no knowledge of the claimed invention, would select elements from the cited prior art references for combination in the manner claimed.” *In re Rouffet*. There is no specific teaching on how one of ordinary skill in the art would modify the invention of *Ohlund* to incorporate the use of a surface mount light emitting diode. To place the surface mount light emitting diode within a single aperture formed in the medallion is complex, and is certainly not trivial. There is no teaching in *Ohlund* as to how the invention disclosed therein would be modified to support the use of a surface mount light emitting diode to emit light from within the medallion. Applicants use of the surface mount light emitting diode together with the formation of the single channel supports transmitting light from within the medallion instead of transmitting light into the medallion from an external source. The modifications the Examiner is reading into *Ohlund* would require altering the very structure, use, and application of the invention. The *Ohlund* language still fails to read on or motivate Applicants’ invention. Accordingly, Applicants respectfully contend that the combination of *Ohlund* and *Rapisarda* does not meet the standard set by the CAFC’s interpretation of 35 U.S.C. §103(a), and respectfully requests allowance of claims 12-15 and 23.

#### IV. Rejection of Claim 17 under 35 U.S.C. §103(a)

In the Office Action dated December 14, 2004, the Examiner assigned to the application

rejected claim 17 under 35 U.S.C. §103(a) as being unpatentable over *Ohlund* ('971) in view of *Belknap* ('053), and further in view of *Rapisarda* ('056). The comments pertaining to *Ohlund* provided in response to the First Office Action is hereby incorporated. Applicants have canceled claim 17, and as such any response to this claim is now moot.

**V. Addition of Claims 25-27 and Claims 28-31**

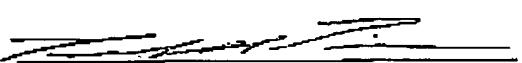
In response to the Office Action dated December 14, 2004, Applicants have added new claims 24-26 and 27-30. Claims 24-26 address the article as including three primary elements: the flexible conductor, the medallion structure, and the placement of the surface mount light emitting diode, and claims 27-30 address the article as including the elements of the medallion, the channel formed in the medallion, and the light emitting diode housed within the channel. As noted above, *Ohlund* discloses a medallion comprised of at least two elements, and the medallion of Applicants specifically limits the medallion to a single element item. Although *Belknap* discloses a medallion comprised of a single element, it does not teach a channel or a single aperture formed in the medallion designed to accommodate a surface mount light emitting diode. The only reference shown by the Examiner to teach a surface mount light emitting diode is *Rapisarda*, which does not relate to placement of the surface mount light emitting diode in the structure of the medallion of Applicant. Absent Applicant's invention, there is no teaching, suggestion or motivation to employ a surface mount light emitting diode in the medallion of *Ohlund* for such a modification as claimed by Applicant in claims 24-26. Similarly, in claims 27-30, there is no teaching, suggestion, or motivation to provide a medallion with a channel extending between two exterior surface, and a light emitting diode house therein. To reject these claims would merely be using hindsight reconstruction to apply the combination of *Ohlund*, *Belknap*, and/or *Rapisarda* to Applicants' invention.

As the CAFC has made clear, the prior art must teach the desirability of the modification in question. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re*

*Gordon et al.*, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is axiomatic that the subject matter of the claims may not be considered obvious as a result of a hypothetical modification of a reference unless something in the reference suggests that an advantage may be derived from the modification. There is no suggestion or motivation to employ a surface mount light emitting diode into the structure of *Ohlund* to enable the medallion to be illuminated from an internal aperture, and thereby improve the radiance of the article, as is suggested by the Examiner. Similarly, there is no suggestion or motivation to employ the structure of the medallion with a single aperture or channel extending between two external surfaces and a light emitting diode housed therein. The desirability of the modification can be found at best only through the use of Applicant's invention. Therefore, the prior art reference does not render Applicant's invention obvious as there is no teaching, suggestion, or motivation to apply elements found in *Ohlund*, *Belknap*, and/or *Rapisarda* to build the article of Applicant.

For the reasons outlined above, withdrawal of the rejection of record and an allowance of this application are respectfully requested.

Respectfully submitted,

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